

02-013 (UCT-0061)
10/620,644



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Patrick Mather et al.)
Serial No.: 10/620,644) Group Art Unit: 1713
Filed: July 16, 2003) Examiner: Choi, Ling Siu
Patent No.: 7,067,606)
Issued: June 27, 2006)
For: NONIONIC TELECHELIC POLYMERS)
INCORPORATING POLYHEDRAL)
OLIGOSILSESQUOXANE (POSS) AND)
USES THEREOF)

**APPLICATION FOR PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705(d)**

Mail Stop Petition
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.705(d), Applicants respectfully request correction of the patent term adjustment from 260 days, as stated on the face of the issued patent, to 419 days for reasons detailed below. Favorable consideration of this application for patent term adjustment is respectfully requested.

07/14/2006 SSITHIB2 00000001 061130 7067606

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REMARKS

Summary

Applicants' Patent No. 7,067,606 B2 indicates a patent term adjustment of 260 days on the face of the patent. The patent term adjustment history in the Patent Application Information Retrieval system (PAIR) indicates that the 260 day adjustment is the net result of an Office delay of 338 days in issuing the patent and a 78 day delay by Applicants in paying the issue fee. Applicants respectfully submit that there was a 419 day Office delay in issuing the patent, and there was no Applicant delay in the payment of the issue fee. Accordingly, the patent term adjustment should be 419 days. Correction of the patent term adjustment to 419 days is respectfully requested.

Fee

Pursuant to 37 C.F.R. § 1.705(d), Applicants are submitting herewith the fee set forth in 37 C.F.R. § 1.18(e) (\$200). Please see attached Fee Sheet for deposit account information.

Statement of the Facts

Pursuant to 37 C.F.R. § 1.705(d) (incorporating by reference the requirements of 37 C.F.R. § 1.705(b)(2)), the following facts are relevant to the requested correction of patent term adjustment.

The Correct Patent Term Adjustment and Basis Therefor

The correct patent term adjustment is 419 days. This patent term adjustment is based on 37 C.F.R. § 1.702, which provides for adjustment of a patent term "due to failure of the office to: * * * (4) Issue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. 151 and all outstanding requirements were satisfied." 37 C.F.R. § 1.702(a)(4).

Relevant Dates and Calculation of Adjustment

Section 1.703(a) provides in relevant part that "[t]he period of adjustment under § 1.702(a) is the sum of the following periods: * * * (6) The number of days, if any, in the period

beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date a patent was issued.” 37 C.F.R. § 1.703(a). As acknowledged by the Office in the Patent Term Adjustment History in PAIR, Applicants timely paid the issue fee on January 4, 2005, thereby satisfying all outstanding requirements. The patent should therefore have issued within four months, or by May 4, 2005. However, the patent did not issue until June 27, 2006. Thus, the period of adjustment runs from May 5, 2005 to June 27, 2006, which is 419 days. There is no basis in 37 C.F.R. § 1.704 for reducing the period of adjustment, so the net patent term adjustment calculated according to 37 C.F.R. § 1.703(f) should be 419 days.

Terminal Disclaimer

The present patent is not subject to a terminal disclaimer.

Circumstances Constituting a Failure to Engage in Reasonable Efforts to Conclude Examination

There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth in 37 C.F.R. § 1.704.

In particular, Applicants note that the Patent Term Adjustment History in PAIR incorrectly attributes to Applicants a 78 day delay allegedly associated with late payment of an issue fee. As noted in the Patent Term Adjustment History, Applicants’ issue fee was timely filed on January 4, 2005. See Attachment 1. The Office’s acknowledgement of timely payment of the issue fee is further corroborated by Office’s decision, on November 11, 2005, to grant Applicants’ petition to withdraw abandonment based on evidence that the issue fee was timely paid. See Attachment 2. Accordingly, there was no delay in Applicants’ payment of the issue fee, and any reduction in the patent term adjustment based on such a delay is incorrect.

Conclusion

The patent term adjustment for the present patent should be 419 days, rather than the 260 days indicated on the face of the patent.

Attachments

Attachment 1 is a copy of the Patent Term Adjustment page in the PAIR record for the present case, printed July 10, 2006.

Attachment 2 is a copy of the November 30, 2005 Decision granting Applicants' Petition to Withdraw Abandonment.

Respectfully submitted,

CANTOR COLBURN LLP
Applicants' Attorneys

By: 

J. Michael Buchanan
Registration No. 44,571

Date: July 11, 2006
Customer No.: 23413
Telephone: (860) 286-2929



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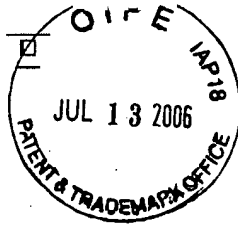
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10/620,644 NONIONIC TELECHELIC POLYMERS INCORPORATING POLYHEDRAL OLIGOSILSESQUIOXANE (POSS) AND USES THEREOF

Application Data	Transaction History	Image File Wrapper	Patent Term Adjustments	Continuity Data	Published Documents	Fees	Publication Dates	Address & Attorney/Agent
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Patent Term Adjustment

Filing or 371(c) Date:	07-16-2003	USPTO Delay (PTO) Delay (days):	338
Issue Date of Patent:	06-27-2006	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	78
Post-Issue Petitions (days):	+0	Total Patent Term Adjustment (days):	260
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
06-27-2006	Patent Issue Date Used in PTA Calculation		338
04-25-2006	Receipt into Pubs		↑
04-24-2006	Dispatch to FDC		↑
03-14-2005	Issue Fee Payment Verified		↑
04-21-2006	Dispatch to FDC		↑
04-21-2006	Application Is Considered Ready for Issue		↑
03-24-2005	Issue Fee Payment Verified		↑
03-24-2005	Issue Fee Payment Verified		↑

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01-04-2005	Issue Fee Payment Received	↑
01-24-2006	Receipt into Pubs	↑
01-16-2006	Withdraw Publication/Pre-Exam Abandon	↑
11-30-2005	Petition to Revive Application - Granted	↑
03-24-2005	Petition Entered	↑
03-03-2005	Mail Abandonment for Failure to Pay Issue Fee	↑
03-03-2005	Abandonment for Failure to Pay Issue Fee	↑
01-05-2005	Correspondence Address Change	↑
12-22-2004	Receipt into Pubs	↑
10-25-2004	Receipt into Pubs	↑
10-21-2004	Workflow - File Sent to Contractor	↑
10-05-2004	Mail Notice of Allowance	↑
10-05-2004	Mail Formal Drawings Required	↑
10-01-2004	Formal Drawings Required	↑
10-01-2004	Notice of Allowance Data Verification Completed	↑
10-01-2004	Case Docketed to Examiner in GAU	↑
09-15-2004	Case Docketed to Examiner in GAU	↑
07-25-2004	IFW TSS Processing by Tech Center Complete	↑
07-25-2004	Case Docketed to Examiner in GAU	↑
07-22-2004	Correspondence Address Change	↑
07-22-2004	Change in Power of Attorney (May Include Associate POA)	↑
07-22-2004	Date Forwarded to Examiner	↑
07-12-2004	Response after Non-Final Action	↑
07-12-2004	Workflow incoming amendment IFW	↑
05-21-2004	Mail Non-Final Rejection	↑
05-17-2004	Non-Final Rejection	↑
04-08-2004	Correspondence Address Change	↑
03-25-2004	Information Disclosure Statement (IDS) Filed	↑
03-24-2004	Case Docketed to Examiner in GAU	↑
02-02-2004	Reference capture on IDS	↑
02-02-2004	Information Disclosure Statement (IDS) Filed	↑
03-16-2004	IFW TSS Processing by Tech Center Complete	↑
03-12-2004	Correspondence Address Change	↑

10-17-2003	Application Return from OIPE
10-20-2003	Application Is Now Complete
10-17-2003	Application Return TO OIPE
10-17-2003	Application Return from OIPE
10-20-2003	Application Is Now Complete
10-17-2003	Pre-Exam Office Action Withdrawn
10-17-2003	Application Return TO OIPE
10-15-2003	Application Return from OIPE
10-16-2003	Application Is Now Complete
10-16-2003	Pre-Exam Office Action Withdrawn
10-15-2003	Application Return TO OIPE
10-15-2003	Application Return from OIPE
10-16-2003	Application Is Now Complete
10-16-2003	Pre-Exam Office Action Withdrawn
10-15-2003	Application Return TO OIPE
10-15-2003	Application Dispatched from OIPE
10-16-2003	Application Is Now Complete
10-02-2003	Cleared by OIPE CSR
10-02-2003	Cleared by OIPE CSR
08-23-2003	IFW Scan & PACR Auto Security Review
07-16-2003	Initial Exam Team nn

If you need help:

- Call the Patent Electronic Business Center at (866) 217-9197 (toll free) or e-mail EBC@uspto.gov for specific questions about Patent Application Information Retrieval (PAIR).
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UNITED STATES PATENT AND TRADEMARK OFFICE

ATTACHMENT 2

Technology Center 1700

Mailed: 11-30-05

MEB

Paper Number:

In re application of

Mather et al.

Serial No. 10/620,644

Filed: July 16, 2003

For: Nonionic Telechelic Polymers Incorporating Polyhedral
Oligosilsesquioxane (POSS) And Uses Thereof

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DECISION ON
PETITION

This is a response to the PETITION TO WITHDRAW ABANDONMENT, filed March 24, 2005. The petition requests that the abandonment, as set forth in the Notice of Abandonment of March 3, 2005, for failure to timely reply to the Notice of Allowance of October 5, 2004 be withdrawn. The petitioner asserts that the issue fee payment was timely filed by mail with the Office on January 4, 2005, with the appropriate fees. A certification of mailing, a signed statement attesting to the previous timely mailing by the person who signed the Certificate of Mailing, and copies of a mailing log are provided as evidence.

DECISION

The instant request is accepted as a timely petition under 37 C.F.R. 1.181 (no fee), and is evaluated under the procedures regarding a Petition To Withdraw Holding of Abandonment Based on Evidence That a Reply Was Timely Mailed or Filed.

As set forth in MPEP 711.03(c) Petition To Withdraw Holding of Abandonment Based on Evidence That a Reply Was Timely Mailed or Filed:

37 CFR 1.10(c) through 1.10(e) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as "Express Mail." A petition to withdraw the holding of abandonment relying upon a timely reply placed in "Express Mail" must include an appropriate petition under 37 CFR 1.10(c), (d), or (e) (see MPEP § 513). When a paper is shown to have been mailed to the Office using the "Express Mail" procedures, the paper must be entered in PALM with the "Express Mail" date.



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Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides prima facie evidence that the reply was timely filed. See MPEP § 503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt. Where a certificate of mailing or transmission under 37 CFR 1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 CFR 1.8(b) and MPEP § 512. As stated in 37 CFR 1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 CFR 1.8).

The petitioner's showing that the issue fee payment was submitted by mail, on January 4, 2005 is sufficient. The application will be forwarded to the issue branch for processing and consideration of the issue fee payment filed January 4, 2005, and a copy of which is provided as an attachment to the instant petition.

The Petition is **Granted**.



UNITED STATES PATENT AND TRADEMARK OFFICE

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Jacqueline M. Stone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

J. Michael Buchanan
Cantor Colburn LLP
55 Griffin Road South
Bloomfield, CT 06002

CERTIFICATE OF MAILING BY FIRST CLASS MAIL (37 CFR 1.8)

Applicant(s): Patrick Mather et al.

Docket No.

02-013 (UCT-0061)

Application No.

10/620,644

Filing Date

7/16/2003

Examiner

Choi, Ling Siu

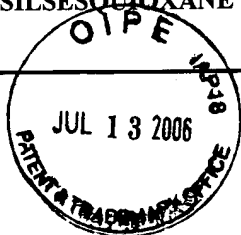
Customer No.

23413

Group Art Unit

1713

Invention: NONIONIC TELECHELIC POLYMERS INCORPORATING POLYHEDRAL
OLIGOSILSESQUOXANE (POSS) AND USES THEREOF



I hereby certify that this Application for Patent Term Adjustment (4 pgs); Attch 1(3 pgs); Attch 2 (3 pgs)

FEE SHEET (1 pg) (Identify type of correspondence)

is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope

addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on

July 11, 2006

(Date)

Rebecca L. Blake

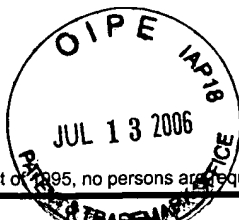
(Typed or Printed Name of Person Mailing Correspondence)

A handwritten signature in cursive script that reads "Rebecca L. Blake".

(Signature of Person Mailing Correspondence)

Note: Each paper must have its own certificate of mailing.

Doc Code:



PTO/SB/17 (01-06)
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Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL for FY 2006

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) **\$200.00**

Complete if Known

Application Number	10/620,644
Filing Date	7/16/2003
First Named Inventor	Patrick Mather et al.
Examiner Name	Choi, Ling Siu
Art Unit	1713
Attorney Docket No.	UCT-0061

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☒ Deposit Deposit Account Number: 06-1130 Deposit Account Name: Cantor Colburn LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or any underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

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FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid(\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**
 _____ - 20 or HP = _____ x \$50.00 = \$0.00

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**
 _____ - 3 or HP = _____ x \$200.00 = \$0.00

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listing under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets **Extra Sheets** **Number of each additional 50 or fraction thereof** **Fee (\$)** **Fee Paid (\$)**
 _____ - 100 = 0 / 50 0 (round up to a whole) x \$250.00 = \$0.00

4. OTHER FEE(\$)

Non-English specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Filing an Application for Patent Term Adjustment

\$200.00

SUBMITTED BY

Signature	<u>Michael Buchanan</u>	Registration No. (Attorney/Agent)	<u>44,571</u>	Telephone	<u>860-286-2929</u>
Name (Print/Type)	<u>J. Michael Buchanan</u>			Date	<u>July 11, 2006</u>

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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